REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 9-11, 15, and 17 have been amended, claims 5-8 and 20-21 have been cancelled without prejudice, and new claims 22-32 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §103

Claims 1-4 and 9-19 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 6,802,659 to Cremon et al. ("Cremon") in view of U.S. patent 6,527,356 to Spurr et al. ("Spurr"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2-4 and 9-10, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Currently amended) In a system comprising an imaging device that is operatively coupled across a network to a server computer, a method comprising:

detecting, by the imaging device, a media ID from print media, <u>the media ID substantially unique to a type of the print media</u>;

responsive to detecting the media ID, <u>determining whether any predetermined sets of media parameters contained in the imaging device correspond to the media ID; and</u>

<u>if none of the predetermined sets of media parameters correspond,</u>

downloading a set of media parameters corresponding to the media ID from the server computer to the imaging device and

automatically configuring the imaging device based on the media parameters downloaded to the imaging device." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

Neither the Cremon nor the Spurr reference teach or suggest predetermined sets of media parameters in the imaging device, and an operation of determining whether the media ID detected from the print media corresponds to any of the predetermined media parameter sets, where if none of the predetermined media parameter sets correspond, then the media parameters are downloaded from a server computer. To the contrary, the Office acknowledges that "[i]n the program of Cremon and Spurr, the downloading of parameters occurs <u>every time</u> a media is detected" (Office Action, p.7). Such operation illustrates that there are no such predetermined sets of media parameters maintained in the imaging device and which could eliminate the need to

download media parameters from outside the imaging device for certain media IDs.

In addition, claim 1 recites that the media ID is substantially unique to a type of the print media. Neither the Cremon nor the Spurr reference teach or suggest the uniqueness of the media ID to a type of the print media.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. Applicants believe that the Cremon reference teaches away from the combination or modification proposed by the Examiner for downloading a set of media parameters corresponding to the media ID from the server computer to the imaging device, as allegedly taught by the Spurr reference. In its Background of the Invention section, the Cremon reference acknowledges that it is possible to "[c]onnect the product to electrical power and a host computer ... which is used to download, via a communication interface, new configuration parameters" (col. 2, lines 6-10). However, this approach is then immediately dismissed by the Cremon reference as "time-consuming and costly" and "impractical and cost-prohibitive" (col. 2, lines 13-28).

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Dependent claim 9 (currently amended) is further patentably distinguishable over the cited references. Claim 9 recites:

"9. (Currently amended) The method of claim 1, further comprising:
responsive to downloading the set of media parameters, updating a look-up-table at the

imaging device to map the media ID to the set of media parameters." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to the limitation of a look-up-table, the Office states that "[a] look-up-table is inherent to memory structure where parameters are stored" (Office Action, p.7; emphasis added).

Applicants respectfully disagree, and believe that the implementation and usage of a look-up-table at the imaging device to map the media ID to the set of media parameters is not inherent. In the rejection of claim 10, the Office states that "[i]n the program of Cremon and Spurr, the downloading of parameters occurs every time a media is detected, providing evidence that only most recently used parameters are stored in the look-up-table of the imaging device" (Office Action, p.7). Applicants agree with the Office that in the program of Cremon and Spurr, the downloading of media parameters occurs every time a media is detected. However, it follows that, because downloading a set of media parameters corresponding to the media ID occurs every time a media is detected, there is no need for either or both of the Cremon and Spurr references to utilize a look-up table. A look-up-table might, arguendo, be useful if multiple sets of media parameters were maintained at the imaging device, and the one of these sets that corresponds to the media ID needed to be selected from among the multiple sets. However, there is no teaching or suggestion in the Cremon and Spurr references that such multiple sets of media parameters are maintained at the imaging device. As such, there would be no need for a table in which to look up which one of the multiple sets of media parameters corresponds to the media ID; there is only one set of media parameters, and that set is the one downloaded when the media is detected. So at least for this reason, use of a look-up-table cannot be considered inherent to the Cremon and Spurr references. A look-up-table would serve no purpose because the parameters would be downloaded every time a media is detected. Thus a look-up-table feature could be found only in hindsight and in light of Applicants' teachings. Therefore, for the additional reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations.

In addition, 37 CFR §1.104(d)(2) requires the Office's reliance on personal knowledge be

appropriately supported. This section states:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavit of the applicant and other persons."

If any of the claims are found to not be allowable, Applicants respectfully request that the Office provide an affidavit pursuant to 37 CFR §1.104(d)(2) in a non-final Action for each allegedly inherent feature which is relied on for a rejection and not supported by a corresponding reference.

Dependent claim 10 (currently amended) is further patentably distinguishable over the cited references. Claim 10 recites:

"10. (Currently amended) The method of claim 1, further comprising:
responsive to downloading the set of media parameters, updating a look-up-table at the imaging device to map the media ID to the set of media parameters such that <u>the look-up-table indicates a plurality of most recently used media ID to set of media parameter mappings.</u>" (emphasis added)

For similar reasons as discussed heretofore with reference to claim 9, Applicants agree with the Office that, in the program of Cremon and Spurr, the downloading of media parameters occurs <u>every time</u> a media is detected, but disagree with the Office's position that a look-up-table in the imaging device is inherent.

In addition, even if, arguendo, a look-up-table were inherent (which Applicants do not concede), there is no teaching or suggestion in the Cremon and Spurr references that it would contain a <u>plurality</u> of most recently used media ID to set of media parameter mappings, as recited in claim 10. It would serve no purpose to do so, in that the Cremon and Spurr references teach that the media parameters are downloaded every time a media is detected. Such a feature could be found only in hindsight and in light of Applicants' teachings. Therefore, for the additional reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim

limitations.

Independent claim 11 (currently amended) recites limitations similar to those of claim 1, discussed above. For similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the cited references in that these features and limitations are neither taught nor suggested by the Cremon reference in combination with the Spurr reference, and in that these references may not be validly combined. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 11, and its corresponding dependent claims 12-14, is improper at least for that reason and should be withdrawn.

The rejection of independent claim 15, and its dependent claim 16, is respectfully traversed for at least the following reasons. Claim 15 recites:

"15. (Currently amended) In a system comprising a server computer that is operatively coupled across a network to an imaging device, a method comprising:
receiving, by the server computer, a media parameter request message comprising a substantially unique media ID that corresponds to a particular type of print media, and at least one of a model type of the imaging device, a software version of the imaging device, and a packaging type of the print media, the media parameter request message having been communicated to the server computer by the imaging device;
responsive to receiving the media parameter request message, evaluating a remote look-up-table to determine a set of media parameters that correspond to the substantially unique media ID and the at least one of a model type of the imaging device, a software version of the imaging device, and a packaging type of the print media; and
downloading the media parameters to the imaging device." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

To whatever extent, if any, that the Cremon and Spurr references disclose a media

parameter request message, neither of the references discloses a <u>structure</u> of the message as recited in claim 15. The recited structure of claim 15 includes: (1) a substantially unique media ID that corresponds to a particular type of print media; and (2) at least one of (a) a model type of the imaging device, (b) a software version of the imaging device, and (c) a packaging type of the print media.

The cited portion of the Cremon reference (col. 11, lines 27-35) refers merely to vague "download data", and it is unclear to Applicants whether a media parameter request message is disclosed at all. There clearly is no disclosure of a media parameter request message having the structure recited in claim 15.

The cited portion of the Spurr reference (col. 17, line 35 – col. 18, line 8) discloses that host computer 280 accepts "media identifier information from remotely located networked server 260" and "returns processing information to control logic processor 130 on the specific media types loaded in printer 230". The Spurr reference also discloses that "host computer 280 is capable of accessing a media information data source 290 that contains detailed test and performance measurements and manufacturing data on each batch of" media (col. 18, lines 9-16). To whatever extent, if any, the media information data source 290 may correspond to the remote look-up-table recited in claim 15, there is no teaching or disclosure that the media identifier information (i.e. media parameter request message) includes the particular structure recited in claim 15, or that the media information data source 290 (i.e. look-up-table) is evaluated to determine a set of media parameters that correspond to the substantially unique media ID and the at least one of a model type of the imaging device, a software version of the imaging device, and a packaging type of the print media, as recited in claim 15.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, and for similar reasons as have been discussed heretofore with regard to claim 1, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 17 (currently amended) recites limitations similar to those of claim 15, discussed above. For similar reasons as explained heretofore with regard to claim 15, the features of the present invention are not taught or suggested by the cited references in that these features and limitations are neither taught nor suggested by the Cremon reference in combination with the Spurr reference, and in that these references may not be validly combined. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 17, and its corresponding dependent claims 18-19, is improper at least for that reason and should be withdrawn.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

Robert C. Sismilich
Reg. No. 41,314
Attorney for Applicant(s)
Telephone: (858) 547-9803

Date: 10/10/06

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400